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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,523	10/11/2001	Masayuki Yoshida	HSTI 0128 PUS	2369
35312	7590	03/17/2004	EXAMINER	
BROOKS KUSHMAN P.C./ HENKEL CORPORATION 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238			TARAZANO, DONALD LAWRENCE	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

- **Advisory Action**

Application No.

09/975,523

Applicant(s)

YOSHIDA ET AL.

Examiner

D. Lawrence Tarazano

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached reasons.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

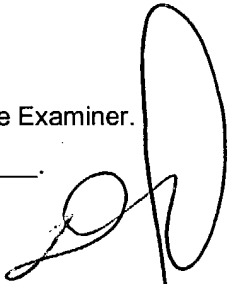
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 14-25 and 27-30.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


D. Lawrence Tarazano
Primary Examiner
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DETAILED ACTION

The applicants state that they unexpected adhesion for the thickness claimed and that they get improved results for the concentration of polymer used:

On page 13 of the specification the applicants state:

For dry-in-place coating in a process according to the invention, the concentration of polymer comprising units conforming to general formula (1) is preferably from 0.01 to 10 g/L and more preferably is from 0.1 to 2 g/L. A satisfactory adhesion is not obtained when the polymer concentration is Less than 0.01 g/L, **while high costs, without adequately corresponding benefits, are incurred when the polymer concentration exceeds 10 g/L.** The concentration of the one or more selections from phosphoric acid-type compounds and organosilicon compounds preferably is at least 0.01 g/L, is more preferably from 0.01 to 30 g/L, and still more preferably is from 0.05 to 3 g/L. The add-on may be inadequate when the concentration of the one or more selections from phosphoric acid-type compounds and organosilicon compounds is below 0.01 g/L, while high costs, without adequately corresponding benefits, are incurred when this concentration exceeds 30 g/L.

On the Thickness of the coating the applicants state on page 10:

The coating on the coated metal according to the present invention must exhibit a thickness of 5 to 500 nm, preferably has a thickness of 15 to 300 nm, and more preferably of 50 to 300 nm. An excellent adherence by the laminated film is not obtained at coating thickness below 5 nm, while exceeding 500 nm has a high potential for impairing the color of the metal. The overall coating weight of the coating must include 5 to 500 mgs carbon per m² and is preferably from 50 to 200 mg/m². **An excellent adherence is not obtained when the total coating weight is below 5 mg/ m², while exceeding 500 mg/m² has a high potential for impairing the color of the metal.**

The examiner is not convinced that the applicants have shown unexpected results for what they are claiming and there does not appear to be support for a value of "1.9" as proposed in the amendment. It is clear that more that polymer would be more expensive and that if the coating is too thick, it would cause the surface to be obscured. Furthermore, there is no difference between "**about 2.0**" as taught in the prior art and the value of "1.9" proposed in the

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amendment. The minimum concentrations / thickness recited is merely common sense. If a coating becomes too thin it will not function.

There also appears to be a fundamental problem with the claim. The applicants claim both the concentration of the polymer and other items and then the thickness of the (dried layer?). There appears to be concepts in the claim that relate to different stages in the structure. It is not clear if the coating is dried or wet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (571)-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Lawrence Tarazano
Primary Examiner
Art Unit 1773



dlt